

## REMARKS/ARGUMENTS

The claims are 1, 2, 7, 9, 11, 14, 16-21, 24-26 and 28-31. Claim 1 has been amended to incorporate subject matter previously appearing in claims 10, 15, 22 and 23. Accordingly, claims 10, 15, 22 and 23 have been canceled, and claims 16, 18, 20 and 21 which previously depended on claim 15 have been amended to depend on claim 1. Reconsideration is expressly requested.

Claims 1, 2, 9-11, 22, 23 and 28-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Stierli U.S. Patent No. 4,442,148* in view of *Hurst U.S. Patent No.3,900,102*. Claims 1, 2, 7, 9-11, 14 and 22-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Jenkins et al. U.S. Patent No. 5,824,401* in view of *Hurst*. Claims 1, 2, 7, 9-11, 14-16, 18, 20-26 and 28-30 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Wiercinski et al. U.S. Patent No. 5,687,517* in view of *Hurst*. Claims 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Wiercinski et al.* in view of *Hurst et al.* and further in view of *Zickell et al. U.S. Patent No. 4,992,315*. Claim 31 was rejected under 35 U.S.C. §103(a) as being

unpatentable over *Stierli* or *Wiercinski et al.* in view of *Hurst* and further in view of *Kalkanoglu U.S. Patent No. 4,757,652*.

Essentially, the Examiner's position was that any of *Stierli, Jenkins et al., Wiercinski et al.* discloses the film-bitumen combination recited in the claims except for a first edge of the at least two film layers projecting beyond the bituminous layer and a second edge of the at least two film layers being shorter than the bituminous layer, that *Hurst* discloses this feature, and that it would have been obvious to one of ordinary skill of the art at the time the invention was made would have modified the edges of the two film layers in the primary references to have the first edge of the first layer projecting beyond a bituminous layer and a second edge of the film layer being shorter than the bituminous layer as suggested by *Hurst* in order to form a continuous membrane which does not contain and is not susceptible to the formation of channels for the flow or collection of water and is highly resistant to damage during installation and failure thereafter when joined with other bituminous/film strips and laminated to a substrate.

*Zickell et al.* was cited with respect to claim 17 and 19 as teaching an embossed non-slip film being shorter along at least one edge of a film-bitumen combination for the purpose of providing a small portion having slip resistance where one can stand to reduce the risk of falling. *Kalkanoglu* was cited with respect to claim 31 as teaching a release liner with several sections for the purpose of allowing the material to be flopped back so that one side can be stuck, and then the other side can be flopped down and stuck.

In response, Applicant has amended claim 1 to incorporate subject matter previously appearing in claims 10, 15, 22 and 23 thereby obviating the rejection over *Stierli, Jenkins, Zickell et al.* and *Kalkanoglu*. With respect to the remaining references to *Wiercinski et al.* and *Hurst* the Examiner's rejection is respectfully traversed for the following reasons.

As set forth in claim 1 as amended, Applicant's invention provides a film-bitumen combination including at least two film layers made from different materials and a bituminous layer coated on the film layers. A surface of a side of the combination facing away from the bituminous layer is treated to

have non-slip properties, and each individual film layer is arranged in the combination in accordance with its thermal stability and its mechanical strength. In this way, Applicant provides a film-bitumen combination that avoids delamination of the plastic films especially in warm weather and is stable during use over time. By combining the individual film layers in accordance with their thermal stability and their mechanical strength, the film combination can be customized to suit the temperatures that occur and to cope with the mechanical stress that can be expected when the film-bitumen combination is walked on. Known films for covering the bituminous/oily substances have the problem that they delaminate when they are in contact with the bituminous/oily substances for long periods of time. These films also swell and become ugly in appearance by discoloring. Applicant's invention avoids this problem by a combination of the features recited in claim 1, as amended.

The primary reference to *Wiercinski et al.* fails to disclose or suggest a film-bitumen combination having the structure recited in Applicant's claim 1 or to teach the benefits accruing from the specific arrangement of each individual film layer in accordance with its thermal stability and its mechanical

strength. *Wiercinski et al.* simply discloses a roofing underlayment including a pressure-sensitive membrane adhesive layer 12 attached to a carrier support sheet 14. There is no disclosure or suggestion in *Wiercinski et al.* of arranging individual film layers in the combination in accordance with their thermal stability and their mechanical strength.

Contrary to the Examiner's position, column 5, lines 14-17 of *Wiercinski et al.* simply refers to a preferred embodiment which is said to have excellent strength and dimensional stability. In this embodiment, two polyolefin composites 22 and 22A are cross-laminated such that the orientation of one film 22 is approximately perpendicular to the other 22A. The cross-laminated film 22/22A is then corrugated with ridges oriented about 40-50 degrees with respect to the orientation of the cross-laminated films of the carrier 14. Thus, rather than disclosing Applicant's film bitumen combination as recited in amended claim 1, *Wiercinski et al.* teaches away from this combination by directing that strength and dimensional stability must be achieved by a particular orientation of one film relative to another and the corrugation of ridges with respect to the orientations of the cross-laminated films of the carrier.

The defects and deficiencies of the primary reference to *Wiercinski et al.* are nowhere remedied by the secondary reference to *Hurst*. *Hurst* simply discloses a waterproofing means and method including a sheet-like substrate and contiguous thereto a membrane of a water-proofing pressure-sensitive adhesive. There is no disclosure or suggestion of Applicant's film-bitumen combination as set forth in amended claim 1 or of arranging each individual film layer in the combination in accordance with its thermal stability and its mechanical strength. Thus, even if one were to combine *Hurst* with *Wiercinski et al.* as suggested by the Examiner, one would still not achieve Applicant's film-bitumen combination wherein each individual film layer is arranged in the combination in accordance with its thermal stability and its mechanical strength.

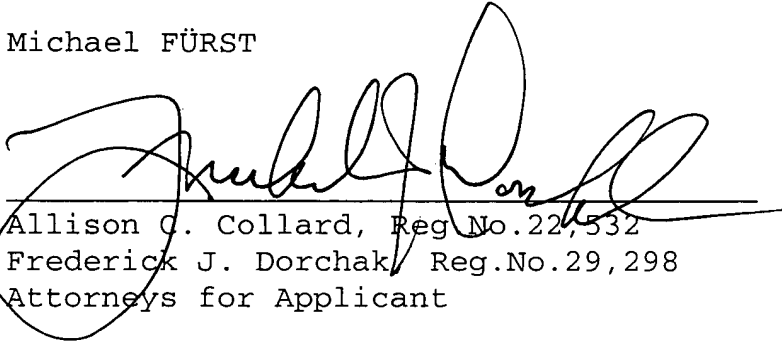
Accordingly, it is respectfully submitted that claim 1 as amended, and claims 2, 7, 9, 11, 14, 16-21, 24-26 and 28-31 which depend directly or indirectly thereon, are patentable over the cited references.

In summary, claims 1, 16, 18, 20 and 21 have been amended, and claims 10, 15, 22 and 23 have been canceled. In view of the

foregoing, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Respectfully submitted,

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Enclosure: Copy of Petition for one-month extension

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 25, 2006.



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